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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,815	05/28/2004	David S. Bonalle	70655.5300	3814
5514	7590	02/28/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			KIM, AHSHIK	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2876	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/709,815	<b>Applicant(s)</b> BONALLE ET AL.	
	<b>Examiner</b> Ahshik Kim	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/28/04 (initial filing of application).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-14,21,22,24-26 and 31-35 is/are rejected.
- 7) ☒ Claim(s) 5,15-20,23 and 27-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/04,11/04,4/05</u> <i>5/05</i>  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continuation Data*

1. Acknowledged this application is a continuation-in-part application of U.S. Serial No.  
5 09/764,688, filed on January 16, 2001, now US Patent 6,742,704, which claims the benefit of US  
Provisional application 60/177,530 filed on January 21, 2000.

### *Information Disclosure Statement*

2. The information disclosure statement filed October 12, 2004 and others fail to comply  
10 with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document;  
each non-patent literature publication or that portion which caused it to be listed; and all other  
information or that portion which caused it to be listed. It has been placed in the application file,  
but the information referred to therein has not been considered.

For documents other than US Patents (i.e., foreign patents and non-patent literature), a  
15 legible copy is required.

Examiner also notes that Applicant submitted a numerous US patents using a software.  
Applicant is reminded that it is Applicant's responsibly to submit statement of relevance as to  
why the items in PTO-1449 are pertinent to the subject matter disclosed in the instant  
application.

20

### *Claim Objections*

3. Even if no claims were to be amended, Applicant is respectfully suggested to submit an  
entire set of presented claims since claim numbers are in the form of [c1], [c2], [c3] .....

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4. Claim 14 is objected. Re claim 14, "said database is RF transaction instrument database" should be rephrased. In Examiner's knowledge, there is no RF database. Database is updated by wireless processing system, which includes RF communication means. In reviewing the specification carefully, Applicant on many occasions uses "RF transaction instrument" which is not RF database.

5. Claim 21, line 2: it is unclear what Applicant means by "Block of Binary". If they are collection of bits (having 0 or 1, on or off, and therefore binary field), they don't need to be capitalized. If they carry a special meaning to warrant capitalization, please indicate in the specification how they are being used. See claim 24 with use of "block of binary."

10

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 10-13, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Brake, Jr. et al. (US 6,032,136, hereinafter "Brake").

Re claims 1 and 12, Brake discloses a method for providing a multiple-service card (col. 2, lines 17+) the method comprising: receiving at a service partner an application for multiple-service from a consumer; reviewing the application information for the services such as phone-card, gasoline card or non-credit transaction card (col. 2, lines 43+); reviewing the application

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information for such services; extracting credit-card information and acquiring additional information for credit-card application (col. 4, lines 62+; col. 9, lines 40+), wherein the credit card provider provides billing, accounting and service functions for the multi-service card (col. 6, lines 5-26).

5           Re claim 2, when the card is sent out to the customer, the pre-built account has been already set up (col. 4, lines 62+). Although not explicitly disclosed, when the card is lost or stolen (col. 5, line 1), the replacement or new card would be sent to the customer. Card generator or card service engine or other elements claimed in claim 2 would be, in the examiner's opinion, included in the pre-building process.

10           Re claim 3 and 4, just like any other credit card, the gasoline card or other transaction card can be canceled, and when the card is canceled, the balance would have to be paid off or the credit returned to the customer (col. 1, lines 28+).

Re claim 10, the card-holder can earn reward points which can be used as the card-holder desires (col. 4, lines 23-25).

15           Re claims 11, the pre-approved form often contains an application identification number or a serial number (col. 4, lines 1-7).

Re claims 13 and 21, the customer's account and other information are kept in the database (col. 9, lines 63+). At a low level, databases stored in the storage medium (hard disk or other permanent storage) use bytes and bites which are block of binary.

20           Re claims 22 and 24, the customer's status is kept (col. 4, line 62+), and the customer's record can be updated (col. 6, lines 5-26).

Re claim 25, see paragraph 9 below for the disclosure of the Taylor reference.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

5 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (US  
10 5,578,808, hereinafter “Taylor”).

Taylor discloses a multiple-application data card (see abstract) and transaction/data management system (col. 2, lines 25+). As shown in figure 1, the card contains a plurality of datasets. Datasets associated with Visa or Mastercard is considered an open transaction instrument since Visa or Mastercard is received virtually everywhere. In case where the card is  
15 used with an oil company or hotels, the card is used in a closed system (col. 3, lines 20+). Information on any one of the card can be updated (col. 4, lines 9-16). If a card is used in ATM embodiment, the ATM or the terminal is a self-service user interaction device.

***Claim Rejections - 35 USC § 103***

20 10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
25 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out  
5 the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brake, Jr. et al. (US 6,032,136) in view of Lalonde (US 5,844,230, hereinafter "Lalonde").

10 The teachings of Brake have been discussed above.

Brake fails to specifically teach or fairly suggest that the card has on the first side, the first indicia associated with the primary party, and second side having a second indicia associated with a service partner.

Lalonde discloses a multiple-service card comprising at least two credit accounts (see  
15 abstract; col. 2, lines 22+). As shown in figures 5 and 6, card 1 information is on the first side, and the second card information on the second side (col. 4, lines 40+; col. 6, lines 64+). As shown in figure 1, the card contains service provider name, holder name, account number, valid dates, and magnetic strip and signature block on the other side (or on the same side see figures 5 and 6).

20 In view of Lalonde's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to design a multi-service card such that a first service provider information is on the first side, and the second service provider information is on the

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second side. Such design would help the card-holders and the service provider to charge accurately for the purchases being made. By designing such cards, obviously, a number of cards a consumer must carry is reduced, and therefore an obvious improvement.

13. Claims 14, 26, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
5 Brake, Jr. et al. (US 6,032,136) in view of Jun et al. (US 5,828,044, hereinafter "Jun").

The teachings of Brake have been discussed above.

Brake fails to specifically teach or fairly suggest that the card has RF communication means to perform the transaction.

Jun discloses a credit card 40 which contains RF communication means for the card-  
10 holder to perform various transactions (see abstract; col. 1, lines 5+; col. 2, lines 1+).

In view of Jun's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate the RF communication means to the generally known credit card in order to allow the card-holder to perform transaction in wireless manner. In some embodiment, wireless card is more convenient, and provides improved security since the  
15 card can still be at the holder's possession, reducing the opportunities where the card information can be stolen.

#### ***Allowable Subject Matter***

14. Claims 5, 15-20, 23, and 27-30 are objected to as being dependent upon a rejected base  
20 claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



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15. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at a method for providing a multiple-service card. The application contains a service partner application information and credit card application information, and both have to approve the use of the card at approved establishment. Such combination card is generally known in the art. However, cited references, taken alone or in combination, fail to disclose or suggest transferring an account to a second service partner, or use of condition header in manipulating the first and second data sets.

### Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: McKenthun (US 5,969,318); Walker et al. (US 6,144,948); Manchester et al. (US 6,915,277); Zacharias (US 6,494,367); Macklin et al. (US 6,732,919) disclose multi-service cards. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Primary Examiner  
Art Unit 2876  
February 13, 2006